

Claims 1-19 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for the reasons set forth on page 2 and 3 of the Office Action. Claims 1 and 10-17 have been amended, rendering this rejection moot.

A term in the claims may be given a special meaning in the description of the invention. In other words, applicants can be their own lexicographers, *i.e.*, applicants can define in the claims what they regard as their own invention essentially in whatever term they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. *See, In re Swinehart*, 439 F.2d 210, 160 U.S.P.Q. 226 (C.C.P.A. 1971); MPEP § 2173.01. When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 U.S.P.Q.2d 1320 (Fed. Cir. 1989); MPEP 2173.05(a). Additionally, a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. *In re Swinehart*, 439 F.2d 210, 160 U.S.P.Q. 226 (C.C.P.A. 1971), *see also* MPEP 2173.01. The claims should not be rejected for non-inclusion of additional limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recited such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. *See In re Skrivan*, 427 F.2d 801, 806, 166 U.S.P.Q. 85, 88 (C.C.P.A. 1970).

Claims 15 and 16 were rejected as allegedly being indefinite because of the use of the term "grid-like." The Office Action alleges that the specification fails to provide a standard measure for "grid-like" and no functional definition is provided having a "grid-like" shaping. *See*, Office Action at page 3, ¶ 8. The term "grid-like" is well known in the art and is used in the specification and claims of patents predating the filing date of the present application without further explanation because a skilled artisan readily understands the significance of the term. For example, U.S. patent No. 5,242,435 to Murji *et al.* which issued on September 7, 1993 recites the term "grid-like" in claim 13. U.S. patent No. 5,589,243 which issued on December 31, 1996, uses the term "grid-like" throughout the specification without any detail. As the term "grid-like" is amply used in the art prior to the filing date of the present application, Applicants need not define terms known in the art.

Thus, the rejection of claims 1-19 under 35 U.S.C. § 112, second paragraph, cannot stand and should be withdrawn.

Claims 1, 13, 17-22, and 24 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. patent No. 6,145,617 to T. Alts ("Alts") for the reasons set forth at pages 4 and 5 of the Office Action. Applicants respectfully traverse.

It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert denied*, 480 U.S. 947 (1987). Merely listing compounds by name constitutes nothing more than speculation about their potential or theoretical existence. *In re Wiggins, James, and Gittos*, 488 F.2d 538, 542, 179 U.S.P.Q. 421, 425 (C.C.P.A. 1973).

Alts fails to anticipate the present claims because Alts does not recite each and every claim limitation. Alts is directed to a multi-functional insulation for use in vehicles having a porous spring layer **13** and a microporous stiffening layer **14** (col. 3, ll. 60-65). The microporous stiffening layer preferably consists of an open-pored fiber layer or fiber/foam composite layer with an air flow of $R_f = 500 \text{ Nsm}^{-3}$ to $R_f = 2000 \text{ Nsm}^{-3}$ (col. 3, l. 65 to col. 4, l. 2).

The present claims are directed to a heat-insulating and soundproofing lining for the engine compartment of a motor vehicle, comprising: a first covering layer; a duroplastic foam layer in planar contact with the first covering layer, wherein the duroplastic foam layer has a long-term thermal loadability at 200°C of three weeks; a soundproofing layer in planar contact with the duroplastic foam layer, wherein the soundproofing layer is selected from the group consisting of plastic foam, particle composite foam, and a non woven fabric wherein the non woven fabric consists of at least one natural fibers and synthetic fibers; and a second covering layer in planar contact with the soundproofing layer.

Alts fails to anticipate the present claims. Specifically, Alts fails to disclose a duroplastic foam layer has a long-term thermal loadability at 200°C of three weeks. Based on the figures within Alts, layer 13 is comparable to the duroplastic foam layer of the present claims. The description within Alts of the porous spring layer does not disclose or even suggest that the layer possess a long term thermal loadability as that found in the present claims.

Consequently, the rejection of claims 1, 13, 17-22, and 24 under 35 U.S.C. § 102(e) as anticipated by Alts cannot stand and should be withdrawn.

Claims 2, 3, 4-12, 14-16, and 23 stand rejected under 35 U.S.C. 103(a) as rendered obvious over Alts for the reasons set forth on pages 5-7 of the Office Action. Applicants respectfully traverse.

The consistent criterion for determination of obviousness is whether the prior art would have suggest to one of ordinary skill in the art that claimed subject matter should be carried out and would have a reasonable likelihood of success. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). As the Examiner is well aware, in order to form a proper basis for a rejection under 35 U.S.C. § 103, the prior art must provide some suggestion, either explicit or implicit, of the combination that allegedly renders a claimed invention obvious. *M.P.E.P.*, § 2142 (June 1998), *see also*, *Panduit Corp. v. Denisson Manufacturing Co.*, 1 U.S.P.Q.2d 1593, 1597 (Fed. Cir. 1987). The Examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Sang Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002); citing *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The need for specificity is paramount, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed. *Id.* The Examiner's conclusory statements do not adequately address the issue of motivation to combine; the factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.*

As discussed above, Alts is directed to a sound insulating assembly. Alts, however, fails to disclose or suggest either implicitly or explicitly a layer possessing a long term thermal loadability at 200°C of three weeks. In particular, the present claims recite a durplastic foam layer having the above recited thermal loadability. In contrast, the corresponding layer in Alts, *i.e.* the porous spring layer 13, does not possess the thermal loadability property. More importantly, Alts fails to suggest this property.

Accordingly, the rejection of claims 2, 3, 4-12, 14-16, and 23 under 35 U.S.C. § 103(a) as rendered obvious by Alts cannot stand and should be withdrawn.

Accordingly, it is believed that claims 1-24 are now in condition for allowance, early notice of which would be appreciated.

If any outstanding issues remain, the examiner is invited to telephone the undersigned at the telephone number indicated below to discuss the same. No fee is believed to be due for the submission of this response. Should any fees be required, please charge such fees to Brobeck, Phleger & Harrison, LLP Deposit Account No. 50-1640.

Respectfully submitted,

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By: Craig L. Puckett
Craig L. Puckett (Reg. No. 43,023)

Brobeck, Phleger & Harrison LLP
Intellectual Property Department
1333 H Street, N.W., Suite 800
Washington, D.C. 20005
(202) 220-6000